

Response filed March 22, 2006

Application No. 10/002,328

Response to Office Action mailed December 22, 2005

**REMARKS**

The Office Action of December 22, 2005 has been reviewed and the comments therein were carefully considered. Claims 1-2, 4-15, 17-22, and 24-39 are pending. Claims 1-2, 4-5, 9, 13, 17, 22, 24-25 and 29 have been amended. Claims 3, 16 and 23 have been cancelled. Claim 39 is new. Claims 1-38 stand rejected. Claims 1, 3-9 and 11-16 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,580,948 to Hauptert *et al.* (Hauptert). Claims 2, 10, 17-21 and 23-32 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,662,691 to Behan *et al.* (Behan) in view of Hauptert. Claims 22 and 33-38 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Behan in view of Hauptert in further view of U.S. Patent No. 6,738,670 to Almendinger *et al.* (Almendinger). No new matter has been introduced into the application. As explained in more detail below, Applicants submit that all claims are in condition for allowance and respectfully request such notification.

**Amended Claims**

Claims 1-2, 4-5, 9, 13, 17, 22, 24-25 and 29 have been amended to clarify the intended scope of the claimed subject matter.

Independent claims 1, 2, 13, 17 and 22 now all recite a feature similar to the feature "wherein the programmer is configured to provide to the external neural stimulator configuration information for a type of an implantable neural stimulator that is to be implanted" recited in claim 1. As this feature was previously recited in a dependent claim, no new matter has been added by these amendments.

**Cancelled Claims**

Claims 3, 16 and 23 have been cancelled, thus mooted the rejection of these claims. The cancelling of these claims is without prejudice to the refiling of similar claims in a continuation application.

**New Claim**

Claim 39 is new. Support for the subject matter of claim 39 is at least found on page 8, paragraph 30 of the specification. Thus, no new matter has been added.

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**Claim Rejections Under 35 USC §103 - Hauptert**

Claims 1, 4-9 and 11-15 are rejected under 35 USC §103(a) as being unpatentable over U.S. Patent No. 6,580,948 to Hauptert, *et al.* ("Hauptert"). Claims 1 and 13 are independent.

Looking at claim 1, it has been amended to recite the feature "wherein the programmer is configured to provide to the external neural stimulator configuration information for a type of an implantable neural stimulator that is to be implanted." Applicants respectfully submit that this feature cannot fairly be said to be disclosed, suggested or taught by Hauptert. As Hauptert fails to disclose or suggest or teach all the features of claim 1, Hauptert fails to support a *prima facie* case of obviousness with respect to claim 1. Therefore, independent claim 1 is nonobvious in view of Hauptert.

Claims 3-9 and 11-12 depend from claim 1 and are nonobvious for at least the reasons discussed above with respect to claim 1 and for the additional limitations recited therein.

Looking at independent claim 13, the feature "wherein the programmer is configured to provide to the external neural stimulator configuration information for a type of an implantable neural stimulator that is to be implanted" is recited. For reasons similar the reasons discussed above with respect to claim 1, claim 13 is nonobvious in view of Hauptert.

Claims 14-15 depend from independent claim 13 and are nonobvious for the reasons discussed with respect to claim 13 and for the additional limitations recited therein. For example, claim 15 recites a patient programmer with the features recited in claim 13 and the Office Action has failed to provide any support for the assertion that such a feature is disclosed in Hauptert.

Therefore, withdrawal of this ground of rejection is respectfully requested.

**Claim Rejections Under 35 USC §103 - Behan & Hauptert**

Claims 2, 10, 17-21 and 24-32 are rejected under 35 USC §103(a) as being unpatentable over Behan in view of Hauptert. Claims 2 and 17 are independent.

Looking at claim 2, the feature "a programmer having a user interface to allow entry of the therapy parameters by a user ... wherein the programmer is further configured to provide to the external neural stimulator configuration information for a type of the implantable neural stimulator that is to be implanted" is recited. Applicants have reviewed the cited references and have been unable to find any disclosure, suggestion or teaching of such a feature. Nor has the

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Office Action pointed to any place in the cited references as disclosing, suggesting or teaching this feature. Accordingly, the references of record fail to support a *prima facie* case of obviousness and claim 2 is nonobvious in view of the references of record.

Claim 10 depends from independent claim 1 and necessarily includes the feature of claim 1. As noted above, Hauptert fails to disclose all the features of claim 1. The Office Action has not suggested that Behan corrects the above noted deficiency, nor does Behan appear able to do so. Therefore, the combination of Behan and Hauptert fails to disclose all the features of claim 10 and do not support a *prima facie* case of obviousness. Thus, claim 10 is patentable over the combination of Behan and Hauptert.

Independent claim 17 is directed toward a method of providing therapy parameters and recites the feature "providing initial therapy parameters to the external neural stimulator" and "providing configuration information for the type of implantable neural stimulator that is to be programmed." Applicant respectfully submits that the above combination of features is not disclosed by the combination of Behan and Hauptert. As Behan and Hauptert fail to disclose all the features of claim 17, Behan and Hauptert fail to support a *prima facie* case of obviousness with regard to claim 17. Therefore, claim 17 is patentable over the references of record.

Claims 18-21 and 24-32 depend from independent claim 17 and are nonobvious in view of the cited references for at least the reasons discussed above with respect to claim 17 and for the additional limitations recited therein.

Accordingly, withdrawal of this ground of rejection is respectfully requested.

**Claim Rejections Under 35 USC §103 – Behan in view of Hauptert and Almendinger**

Claims 22 and 33-38 are rejected under 35 USC §103(a) as being unpatentable over Behan in view of Hauptert and in further view of Almendinger. Claim 22 is independent.

Looking at claim 22, the feature "a physician programmer ... wherein the physician programmer is further configured to provide to the external neural stimulator configuration information for a type of the implantable neural stimulator that is to be implanted" is recited. Applicants respectfully submit that Almendinger fails to disclose such a feature. As noted above, neither Behan nor Hauptert disclose this feature. Thus, the combination of Behan, Hauptert and Almendinger fails to disclose all the features of claim 22 and the references of record fail to support a *prima facie* case of obviousness. Accordingly, claim 22 is patentable over the references of record.

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Claims 33-38 depend from independent claim 22 and are patentable over the references of record for the reasons supporting the patentability of claim 22 and for the additional limitations recited therein.

**CONCLUSION**

Applicants therefore respectfully request reconsideration of the pending claims and a finding of their allowability. A notice to this effect is respectfully requested. Please feel free to contact the undersigned should any questions arise with respect to this case that may be addressed by telephone.

Respectfully submitted,

Dated: March 22, 2006

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